

#### DETAILED ACTION

1. Claims 1, 4, 6-12, 15-21, 24, 26-27, and 30-31 are pending in this application and presented for examination.

#### *Response to Arguments*

2. Applicant's arguments have been fully considered but they are not persuasive.
3. As to claim 12, Applicant argues the language used by Examiner, "ISPs will choose among different invalidation rules" does not accurately reflect the claim language, "a set of rules that is associated with the corresponding ISP for classifying the failure message."

In response to applicant's argument that "determining a set of rules that is associated with the corresponding ISP for classifying the failure message" is not well known in the art, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on

combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Aoki discloses classifying failure messages as discussed in the prior art rejections below and in the previous Office action. Additionally, the Examiner has stated that it was well known in the art that different ISPs will choose among different invalidation rules. Therefore, in the combination of Aoki and what was well known in the art, the determination of a set of rules for classifying a failure message will be associated with a corresponding ISP.

4. Applicant's remaining arguments are directed to amended subject matter. The amended subject matter is properly addressed under the prior art rejections and allowable subject matter sections of the Office action below.

***Allowable Subject Matter***

5. Claims 27 and 30-31 are allowed.
6. The following is a statement of reasons for the indication of allowable subject matter: the prior art fails to disclose, teach, or suggest logic to determine if an email address should

be marked as invalid based on the failure type determined **and the corresponding ISP associated with the email address** (emphasis added).

***Claim Rejections - 35 USC § 102***

7. Claims 1, 4, 6, 8, 10-11, 18, 24, and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Aoki, U.S. Patent No. 7,194,484 B2.

8. As to claim 1, Aoki discloses a method for managing failure messages for email messages, the method comprising:

receiving a failure message from an Internet service provider (ISP) when the ISP is unable to deliver an email message to an email address associated with the ISP (Col. 4, ln. 26-28, 34-38, and 44-57; an email address is associated with an Internet service provider, in that the email address must be provided service by an Internet service provider in order to receive email messages from the Internet);

determining, for the failure message, a failure type based on a determined rule for classifying the failure message (Col. 4, ln. 44-57); and

performing an action in response to receiving the failure message (Col. 5, ln. 5-10 and 15-22),

wherein the action is determined based upon the determined failure type (Col. 4, ln. 44-57; Col. 5, ln. 5-10 and 15-22; the claim language specifies the determination may be done “at least in part” according to the failure type and the ISP, therefore the “part” may be the failure type, as “at least in part” does not indicate the determination is done relying on both in whole).

9. As to claim 8, the claim is rejected for reasons similar to claim 1 above.

10. As to claim 4, Aoki discloses the action comprises marking the email address as invalid (Col. 7, ln. 17-20).

11. As to claim 6, Aoki discloses the action comprises storing information for the email address based on the failure type determined (Col. 5, ln. 5-10).

12. As to claim 10, Aoki discloses the failure message comprises a failure message that is determined after delivery of the email message (Col. 5, ln. 5-10 and 15-22).

13. As to claim 11, Aoki discloses the failure message comprises a failure message sent by the ISP (Col. 4, ln. 22-25 and 26-28).

14. As to claim 18, the claim is rejected for reasons similar to claim 1 above.
15. As to claim 24, the claim is rejected for reasons similar to claim 4 above.
16. As to claim 26, the claim is rejected for reasons similar to claim 6 above.

***Claim Rejections - 35 USC § 103***

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 7, 12, 15-17, and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoki as applied to claims 1 and 18, in view of what was well known in the art at the time of the invention.
19. As to claim 7, Aoki discloses the invention substantially as in parent claim 3, including different actions being performed by ISP servers (Col. 6, ln. 50-56) and different

invalidation rules for marking the email address as invalid (Col. 5, ln. 5-10 and 15-22), but is silent on different ISPs having different invalidation rules.

However, Official Notice (See MPEP 2144.03) is taken that, given the disclosure of multiple invalidation rules (Aoki: Col. 5, ln. 5-10 and 15-22) and the inherent presence of multiple ISPs, different ISPs will choose from among different invalidation rules, and thus have different invalidation rules. To not allow such a scenario, would limit ISPs to static invalidation rule assignments and disallow any customization based on individual ISP preferences.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Aoki in the above-mentioned manner in order to gain the above-mentioned benefits.

20. As to claim 19, the claim is rejected for reasons similar to claim 7 above.

21. As to claims 12 and 20, the claims are rejected for reasons similar to claims 1 and 7 above.

22. As to claim 15, Aoki and what was well known in the art disclose the invention substantially as in parent claim 12, wherein determining if the email address should be

marked as invalid based on the invalidation rule comprises marking the email address as invalid if a failure message for the failure type has been received a certain number of times (Aoki: Col. 5, ln. 5-10).

23. As to claim 16, the claim is rejected for reasons similar to claim 6 above.
24. As to claims 17 and 21, the claims are rejected for reasons similar to claim 8 above.
25. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aoki as applied to claim 1 above, in view of McDowell et al. (McDowell), U.S. Patent No. 6,438,583 B1.
26. As to claim 9, Aoki discloses the invention substantially as in parent claim 1, but is silent on the failure message comprises a failure message email message that is determined before delivery of the email message.

However, McDowell discloses the failure message comprises a failure message email message that is determined before delivery of the email message (Fig. 1; Fig. 3; Col. 6, ln. 62-65; Col. 8, ln. 37-39).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Aoki by determining a failure message prior to delivery

of an email message as taught by McDowell in order to prevent further processing if a request is not valid (McDowell: Fig. 1; Col. 6, ln. 62-65).

### ***Conclusion***

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See the Notice of References Cited (PTO-892).

28. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.



29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN P. WHIPPLE whose telephone number is (571)270-1244. The examiner can normally be reached on Mon-Fri (10:30 AM to 7:00 PM EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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